THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROBERT A. KRONENBERGER

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Appeal No. 96-0885
Application 08/108,932[1]

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ON BRIEF

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Before DOWNEY, HANLON and OWENS, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-3, 5-9 and 11-21. Claims 4 and 10, which are the only other claims remaining in the application, have been

[1] Application for patent filed August 18, 1993.

canceled.

THE INVENTION

Appellant's claimed invention is directed toward a method for making an edible chip, such as a potato chip, which is bent along a fold line, and an edible chip so produced. Appellant states that the chip is sufficiently thin to be crisp, yet is sufficiently rigid to allow scooping of dips without being broken (specification, page 3, lines 12-14). Appellant's claims include five independent claims, i.e., claims 1, 12, 15, 17 and 21, which are illustrative and are appended to this decision.

THE REFERENCES

Humphrey	2,147,098	Feb. 14, 1939
Robinson et al. (Robinson)	3,384,496	May 21, 1968
Mercenari	5,009,902	Apr. 23, 1991
Yoshida (JP '146)[2] (Japanese Kokai)	62-91146	Apr. 25, 1987

THE REJECTIONS

[2] Our consideration of this reference is based on the English translation thereof which is of record.

Claims 1-3, 5-9 and 11-21 stand rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification fails to provide an adequate written description and an enabling disclosure of the claimed invention. Claims 1, 5, 6, 8, 12, 17 and 19-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Robinson. The claims stand rejected under 35 U.S.C. § 103 as follows: claims 7, 9, 13, 14, 18, 20 and 21 over Robinson; claims 11, 19 and 21 over Robinson in view of Humphrey; claims 15 and 16 over Robinson in view of Humphrey and JP '146; claims 1-3, 5-9 and 11-21 over Mercenari in view of Humphrey.[3]

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the aforementioned rejections are not well founded. Accordingly, these rejections will be reversed.

Rejection of claims 1-3, 5-9 and 11-21

[3] In the examiner's answer (pages 4 and 8), the statements of the rejections under 35 U.S.C. § 112, first paragraph and under 35 U.S.C. § 103 over Mercenari in view of Humphrey incorrectly include claim 10 which has been canceled (amendment filed on August 8, 1994, paper no. 4, page 3).

under 35 U.S.C. § 112, first paragraph

The examiner argues that appellant's specification does not describe or enable consistently folding a potato slice (answer, pages 4 and 10).

A specification complies with the 35 U.S.C. § 112, first paragraph, written description requirement if it conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). The examiner has the initial burden of establishing a *prima facie* case of lack of an adequate written description. *See Wertheim*, 541 F.2d at 265, 191 USPQ at 98.

Appellant's specification (page 3, lines 7-14) discloses that bending the sheet layer of flexible, edible material about a fold line permits consistently bent chips to be formed. The examiner has not explained, and it is not

apparent, why this disclosure would not have conveyed to one of ordinary skill in the art that as of appellant's filing date, appellant was in possession of a process wherein the sheet layers are consistently folded about a fold line as recited in appellant's claims.

A specification complies with the 35 U.S.C. § 112, first paragraph, enablement requirement if it allows those of ordinary skill in the art to make and use the claimed invention without undue experimentation. *See In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.,* 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984). The examiner has the initial burden of establishing lack of enablement. *See Wright*, 999 F.2d at 1561, 27 USPQ2d at 1513.

The examiner argues that he does not see how the defining means on the sheet layer which allows the sheet layer to be consistently folded can function without the use of rod/support 16 which is not recited in any of appellant's claims. The examiner, however, does not explain why one of ordinary skill in the art, in view of appellant's

specification, could not have carried out appellant's claimed invention without undue experimentation in the absence of that rod or support.

For the above reasons, we find that the examiner has not carried his burden of establishing a *prima facie* case of lack of an adequate written description or an enabling disclosure. The rejection under 35 U.S.C. § 112, first paragraph, therefore is reversed.

Rejections of claims 1, 5, 6, 8, 12, 17 and 19-21 under 35 U.S.C. § 102(b) and claims 7, 9, 13, 14, 18, 20 and 21 under 35 U.S.C. § 103 over Robinson

Robinson discloses a process wherein apple slices which may have a hole therein where the apple core has been removed are heated and dried to distort them such that at least a part of the perimeter and adjacent area of one side of each slice and at least part of the perimeter and adjacent area of the opposite side of the slice are bent at least proximate to one another (col. 1, lines 30-47; col. 3, lines 7-13). In many cases, the opposite sides of a slice contact one another either at the perimeter or the area immediately adjacent to the perimeter (col. 2, line 66 - col. 3, line 2). The slices

are heated and dried using hot, dry air at a temperature of about 140EF to about 300EF and a relative humidity of up to 5.5% (col. 2, lines 4-9). While the slices are heated and dried, they can be vertically suspended from a bar, hook, wire or the like, tumbled in a rotating drum, subjected to free fall in a wind tunnel, placed in a box or press and pressed to distort them, or pressed in a mold to shape them (col. 1, lines 49-70). After the apple slices are heated, they are exposed to cool, dry air which fixes their physical form (col. 2, lines 55-58). The apple slices become brittle when they have cooled to a temperature below about 130EF (col. 2, lines 58-59).

Appellant's independent claim 1 requires means on the sheet layer to allow the sheet layer to be consistently folded in a predetermined fashion about a fold line, and independent claims 17 and 21 require means on the sheet layer for facilitating bending of the sheet layer consistently at a fold line.

The examiner argues that the hole in the center of Robinson's apple slices is the means which allows the slices to be consistently folded about a fold line (answer, page 11).

The examiner does not explain, however, and it is not apparent, how the hole allows the slices to be consistently folded about a fold line.

Appellant's claim 12 requires a space between the sheet layer walls at a midportion between the fold line and the first location where an apple slice surface abuts to itself. Robinson teaches that the perimeter 36 and perimeter 38 in Fig. 4 are proximate to one another but do not contact one another (col. 4, lines 36-39). The adjacent area 50 of the side 34 contacts the adjacent area 52 of the side 32, as shown in Figs. 4 and 8 (col. 4, lines 40-41). The line about which the apple slice in Fig. 4 is folded, however, is spaced from side 32. That is, side 32 in Fig. 4 is curved, whereas the fold line passes through the ends of curved portion 32 such that there is empty space between the fold line and side 32 where the surface abuts itself. There is

no space between sheet layer walls at a midpoint of this region as required by appellant's claim 12.

In order for a claimed invention to be anticipated under 35 U.S.C. § 102(b), all of the elements of the claim must be

found in one reference. *See Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). As discussed above, the examiner has not explained where the Robinson disclosure meets all of the limitations of any of appellant's independent claims to which the rejection under 35 U.S.C. § 102(b) is applied. The examiner therefore has not met his initial burden of establishing a *prima facie* case of anticipation. *See In re Spada*, 911 F.2d 705, 707, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986). Thus, the rejection under 35 U.S.C. § 102(b) over Robinson is reversed.

The examiner does not explain, and we do not independently find, where Robinson would have fairly suggested, to one of ordinary skill in the art, the elements of the independent claims discussed above. We therefore do not sustain the rejection under 35 U.S.C. § 103 over Robinson.

Rejection of claims 11, 19 and 21 under 35 U.S.C. § 103 over Robinson in view of Humphrey

Humphrey discloses a thin, elongated slice of bread

having narrow compressed portions along its width which serve as hinges at which the bread can be folded for forming a sandwich (page 1, left column, lines 27-51; Figs. 5-8).

The examiner argues that incorporating Humphrey's fold lines into Robinson's apple slice would have been obvious to one of ordinary skill in the art to aid in the bending of the apple slice (answer, page 6). The examiner does not explain, however, where the references indicate that such an aid in bending would be desirable or would result in a product being produced which is shaped in the manner desired by Robinson.

In order for a *prima facie* case of obviousness of appellants' claimed invention to be established, the prior art must be such that it would have provided one of ordinary skill in the art with both a suggestion to carry out appellants' claimed process and a reasonable expectation of success in doing so. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id*. The mere possibility that the prior art could be modified such that appellants'

process is carried out is not a sufficient basis for a *prima facie* case of obviousness. *See In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995). The motivation relied upon by the examiner comes solely from appellant's specification. Thus, the examiner used impermissible hindsight when rejecting the claims. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). We therefore do not sustain the rejection under 35 U.S.C. § 103 over Robinson in view of Humphrey.

Rejection of claims 15 and 16 under 35 U.S.C. § 103 over Robinson in view of Humphrey and JP '146

JP '146 discloses a method for making a dish-shaped rice cracker by making streaky cuts into the edges of a flat rice cake so that when the rice cake is baked, it curls into the shape of a dish (pages 4-6).

The examiner argues that it would have been obvious to one of ordinary skill in the art to make the JP '146 streaky cuts into Robinson's apple slices to aid in the production of

predetermined slice shapes (answer, page 7). The examiner, however, does not point out, and we do not find, where the references indicate that the streaky cuts would aid in producing apple slices which have predetermined shapes or would result in a product having the characteristics desired by Robinson. The only motivation to combine the references as done by the examiner appears to come solely from appellant's specification, which is improper. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d at 1553, 220 USPQ at 312-13; *Rothermel*, 276 F.2d at 396, 125 USPQ at 331.

Appellant argues that the JP '146 dough is preformed into a cup shape and that it does not appear that the score lines cause the sheet to bend as it is heated or dried (brief, page 10). This argument is not well taken because JP '146 teaches that the rice cake initially has a disc shape, and that during heating the streaky cut side is bent such that the disc is curled into a dish-shaped product (pages 4 and 6).

The JP '146 rice cakes having streaky cuts therein are of a non-uniform thickness, i.e., are thinner where the streaky cuts are located, and they bend when heated along fold lines

through the streaky cuts. However, appellant's claim 15 is limited to potato material, whereas JP '146 uses rice cakes. The examiner has not explained, and we do not find, why one of ordinary skill in the art would have considered a potato material and the JP '146 rice dough to be sufficiently similar in nature that the potato material, when cut according to the JP '146 disclosure, would bend in the manner desired in JP '146. We therefore do not sustain the rejection under 35 U.S.C. § 103 over Robinson in view of Humphrey and JP '146.

Rejection of claims 1-3, 5-9 and 11-21 under 35 U.S.C. § 103 over Mercenari in view of Humphrey

Mercenari discloses a taco shell made of a tortilla shaped into a cone having an overlapping edge (col. 1, lines 9-12 and 33-36; Fig. 8).

The examiner argues that it would have been obvious to one of ordinary skill in the art to incorporate Humphrey's fold line into Mercenari's tortilla to aid in the bending of the food surface (answer, page 8). Mercenari's tortilla is formed into a cone, and the examiner has not explained, and it is not apparent, why the references indicate that Humphrey's fold lines would be beneficial in the formation of a cone.

The only motivation for the examiner's combination of the teachings of the references appears to have come from appellant's specification, which is improper. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d at 1553, 220 USPQ at 312-13; *Rothermel*, 276 F.2d at 396, 125 USPQ at 331. Accordingly, the rejection under 35 U.S.C. § 103 over Mercenari in view of Humphrey is reversed.

DECISION

The rejections of claims 1-3, 5-9 and 11-21 under 35 U.S.C. § 112, first paragraph, on the ground that the specification fails to provide an adequate written description and an enabling disclosure of the claimed invention, claims 1, 5, 6, 8, 12, 17 and 19-21 under 35 U.S.C. § 102(b) as being anticipated by Robinson, and the rejections under 35 U.S.C. § 103 of claims 7, 9, 13, 14, 18, 20 and 21 over Robinson, claims 11, 19 and 21 over Robinson in view of Humphrey, claims 15 and 16 over Robinson in view of Humphrey and JP '146, and claims 1-3, 5-9 and 11-21 over Mercenari in view of Humphrey, are reversed.

REVERSED

MARY F. DOWNEY Administrative Patent Judge	)	
ADRIENE LEPIANE HANLON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
TERRY J. OWENS Administrative Patent Judge	)	

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APPENDIX

1. A method of forming an edible chip, said method comprising the steps of:

providing a sheet layer of flexible edible material that can be flattened into a single layer thickness;

defining means on the sheet layer to allow the sheet layer to be consistently folded in a predetermined fashion about a fold line;

folding the sheet layer about the fold line to define first and second sheet layer walls which abut to each other at a first location spaced from the fold line and so that a space is defined between the sheet layer walls between the fold line and the first location; and

treating the sheet layer to rigidify the sheet layer with the first and second sheet layer walls bent about the fold line so that the space is maintained between the sheet layer walls.

12. A method of forming an edible chip, said method comprising the steps of:

providing a sheet layer of flexible edible material that can be flattened into a single layer thickness, said sheet layer having oppositely facing first and second surfaces;

bending the sheet layer about a fold line so that the first surface abuts to itself at a first location spaced from the fold line to define first and second sheet layer walls with a space defined between the sheet layer walls at a midportion between the fold line and the first location; and

treating the sheet layer to rigidify the sheet layer with the first and second sheet layer walls bent about the fold line.

15. A method of forming an edible chip, said method comprising the steps of;

providing a sheet layer of flexible edible potato material having a non-uniform thickness so that the sheet layer resultingly has a tendency to bend along a fold line in a predetermined fashion as a consequence of being at least one of heated and dried; and

at least one of heating and drying the sheet layer so as to cause the sheet layer to bend along the fold line and rigidify in a final state.

17. An edible chip comprising:

a sheet layer made from an edible material that is pliable in a first state and shape retentive in a second

state; and

means on the sheet layer for facilitating bending of the sheet layer consistently at a fold line,

said sheet layer being bent about the fold line in its first and second states so that the first surface on first and second walls defined by the sheet layer abuts to itself at a first location spaced from the fold line.

21. An edible chip comprising:

a sheet layer made from an edible material that is pliable in a first state and shape retentive in a second state; and

means on the sheet layer for facilitating bending of the sheet layer consistently at a predetermined fold line to allow first and second walls on the sheet layer to bend relative to each other about the fold line in response to said sheet layer being immersed in a heated fluid.